Remarks

Reconsideration of this Application is respectfully requested.

Claims 1-3 are pending in the application, with claim 1 being the independent claim.

Applicant notes, with thanks, the withdrawal of finality of the rejection of the Office action mailed November 22, 2002.

The Applicant also notes the re-sending of the Office action originally mailed May 6, 2003, to an address no longer listed on the Power of Attorney. The Applicant thanks the Examiner for setting a new mailing date of May 22, 2003, due to the error on the part of the PTO.

Based on the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn. The Applicant notes that the Examiner has considered the arguments submitted by the Applicant in the previous response, but have rendered said arguments "moot in view of the new ground(s) of rejection." The Applicant acknowledges the withdrawal of all rejections set forth by the Examiner in his action of Paper No. 4.

Objection to Drawings

The drawings have been objected to under 37 CFR 1.83(a) by the Examiner, stating that "The drawings must show every feature of the invention specified in the claims. Therefore, the elastic bands affixed at two separate points on the mask must be shown or the feature(s) canceled from the claim(s)."

Applicant respectfully disagrees. The drawing does show every feature of the invention specified in the claims. The elastic bands affixed at two separate points are not only clearly

indicated in Figure 2 but also described in the specification under number **26.** The Applicant argues that one of ordinary skill would clearly understand the drawing as well as its description in the specification and in the claims. Applicant further argues that because this is clearly understood, no corrections to the drawings are needed.

Rejection of Claims under 35 U.S.C. 103(a)

The Examiner has rejected claims 1-3 as being unpatentable over Rudolph (US Patent No. 5,265,595) "in further view of Dyrud et al." (U.S. Patent No. 5,819,731). The Examiner states that Rudolph teaches an oxygen mask having an improved means for being secured over the nose and the mouth of a patient, the improvement comprising: a pair of elastic bands, both ends of the each pair affixed at points of attachment to each of both sides of the mask, adjustably securable to the patient by pulling the ends anteriorly through the points of attachment, and wherein the elastic bands are affixed at four separate points on the mask. Rudolph fails to teach wherein the bands are extendible to loop over and around each ear of the patient.

Dyrud et al. teaches a mask with common strap for looping around the ear of the patient for securing a mask. Examiner argues that it would have been obvious to one of ordinary skill in the art to modify the mask of Rudolph to include the strap of Dyrud *et al.* to prevent entanglement of the wearer's hair or otherwise ruin the wearer's hair style. Regarding the limitations of claim 3, the Examiner states that "Rudolph/Dyrud teach wherein the elastic bands are affixed at two separate points on the mask (34 or 36)."

Applicant respectfully disagrees. While entanglement of the wearer's hair or otherwise ruining the wearer's hairstyle may be important, neither Rudolph nor Dyrud teach that this is an important function provided by their inventions. Rudolph teaches a mask to provide breath-by-breath measurements of respiration and metabolism. Rudolph does not teach a filtration mask.

Dyrud teaches a filtration mask but does not teach a mask for measuring respiration and metabolism. Neither patent suggests a nexus to the other patent. There is no teaching or suggestion provided by these two patents to combine the two features of their respective masks to arrive at the instant invention of the applicant. Therefore, without the guidance of the Applicant's specification, the Examiner could not have arrived at the Applicant's invention using Rudolph and Dyrud. Applicant argues that the obviousness rejection made by the Examiner is merely hindsight reconstruction based upon the Applicant's disclosure.

It is further argued by the Applicant that the invention of the instant claims is directed to an ***oxygen delivery mask***. Neither of the patents (US Patent No. 5,265,595 and U.S. Patent No. 5,819,731) cited by the Examiner in the obviousness rejection teaches or suggests an oxygen delivery mask. Applicant argues that the art cited is entirely deficient in this regard. The mask taught by U.S. Patent No. 5,819,731 is not an oxygen delivery mask. The mask taught by US Patent No. 5,265,595 is for measuring respiration and metabolism and is designed to have minimum dead space and to be as airtight as possible. As such, it is entirely unsuitable for use as an oxygen delivery mask. It is recognized in the art that an oxygen delivery mask requires the ability to have ambient air to intermix with the oxygen being delivered to the wearer of the mask. Decreasing dead volume and making the mask airtight would not allow this to occur. Additionally, carbon dioxide exhaled by the patient would build up in an airtight mask and could lead to a potentially fatal response in some patients with certain respiratory conditions, such as obstructive pulmonary disease.

Based upon the preceding arguments, applicant therefore requests that the rejection of claims 1-3 under 35 U.S.C. 103(a) be withdrawn.

It is also requested by the Applicant for the Examiner to clarify if there is another secondary reference, besides Dyrud *et al.* under which this rejection is made, since the Examiner stated that the rejection was made "in ***further*** view of Dyrud et al." [emphasis added by Applicant]

Finality of Previous Office Action

Applicant respectfully requests withdrawal of the finality of the previous Office Action, dated May 22, 2003. It is noted that the Examiner on page 2, number 2 of the Office action has stated that the Applicant's arguments are moot in view of "the new ground(s) of rejection." According to the MPEP, § 706.07(a), "second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement ..." The Examiner has stated that "Applicant's amendment dated 09-03-2002 necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**" However, Applicant notes that the new ground(s) of rejection made in the previous Final Office action dated May 22, 2003 could have been made by the Examiner in response to Applicant's amendment dated September 3, 2002 but were not. Instead, an anticipation rejection based upon Brunner (US Patent No. 2,281,744) was made in the Office action dated November 22, 2002 and which has now been replaced with a new ground(s) of rejection. In the Final Office action dated May 22, 2003, the Examiner has not addressed the Applicant's arguments but has instead provided new grounds of rejection and has made moot Applicant's arguments, despite no amendment to the claims. Accordingly, it is

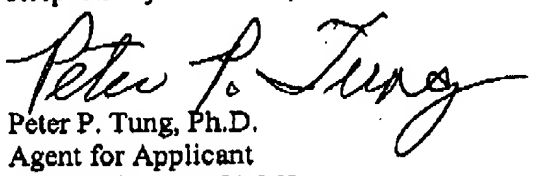
improper for the Examiner to make the previous Office action final. Applicant therefore respectfully requests that the Examiner withdraw the finality of the previous Office Action.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,



Peter P. Tung, Ph.D.
Agent for Applicant
Registration No. 51,269

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6467 Galway Drive
Clarksville, Maryland 21029
(443)691-0177